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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,086

Applicant(s)

ISHIKURA, TOMOHIKO

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on October 5, 2005. This application was under a final rejection (*i.e.* the “First Final Office Action” mailed February 14, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the First Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant’s amendment filed October 5, 2005 is acknowledged. Accordingly, claims 1-10, 13, and 15 remain pending.
3. This Office Action, the “Second Non Final Office Action” is given Paper No. 20051218.
4. All references in this Office Action to the capitalized versions of “Applicant” refers specifically the Applicant of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-5 are rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Because lexicography reads definitions from the specification into the claims and because Applicant's definition of server as supplied in his "Remarks"¹ is not found in the original specification, the claims containing server using Applicant's lexicographic definition contain new matter.

Claim Rejections - 35 USC §112 2nd Paragraph

8. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

¹ See the "Remarks filed October 5, 2005, page 7, under the section "Comments on Response to Arguments", 1st paragraph.

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- a. In claims 1 and 6, the phrase “absolute physical position” is indefinite because it is not known what that “space” in which the “absolute physical position” is in reference to. Is it in reference to a building, the earth, or perhaps the sun?
- b. Also in claims 1 and 6, it is unclear if the “logical position” identifies each load relative to *all* of the other loads of the plurality of loads? And what set of loads is inclusive of “other loads of the plurality of loads”). Would loads at a different factory, warehouse, or plant be within these “other loads of the plurality of loads . . . ?”
- c. Also in claim 1, it is unclear what is “dynamic information”
- d. In claim 6, it is unclear what is meant by “automatically transmitting”

Claim Rejections - 35 USC §102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-10, 13, and 15, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Snellen (U.S. 5,430,831). Snellen discloses a first unit that measures a position of each load (the second, devices measure the dimensions of the respective objects to be placed in a space); a server (the computer) which determines absolute physical position (the computer calculates the actual size of the object) relative to a logical position (0,0,0); and a second unit that determines absolute physical position (calculates the

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actual position including the object dimensions from 0,0,0); the logical position (0,0,0) is available for inventory control (inherent) and is given by three units.

12. Claims 1-10, 13, and 15, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §102(b) as being clearly anticipated by Guthrie (U.S. 5,565,858).

Claim Rejections - 35 USC §103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-10, 13, and 15, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over DD in view of Snellen in view of Shames's Engineering Mechanics, Statics and Dynamics 3rd Ed. ("Shames").² It is the Examiner's principle position that the claims are anticipated because the second unit inherently develops the relative logical position is inherent in Snellen.

However if not inherent, Shames discloses the use of position vectors and how such vectors are translated to various points of reference, the least of which is a 0,0,0 reference. It therefore would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Snellen as taught by Shames to include the second unit developing the relative logical position.

² See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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15. Claims 1-10, 13, and 15, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Guthrie in view of Shames and Greene's Production and Inventory Control Handbook ("Greene") Chopra's and Supply Chain Management, Strategy, Planning, & Operation ("Chopra"). It is the Examiner's principle position that the claims are clearly anticipated by Guthrie. However if not clearly anticipated, Shames discloses as discussed above while Greene and Chopra disclose those features that are old and well known in this art.

So if not inherent, it therefore would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Guthrie as taught by Shames, Greene, and Chopra to disclose those features that are old and well known in the art.

16. It is the Examiner's position that the Groups of Inventions (Invention I being claims 1-5 while Invention II is claims 6-10, 13, and claim 15) are not patentably distinct.

17. For due process purposes and because Applicant has not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicant has decided not to be his own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.³ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim

³ See the First Non Final Office Action mailed June 29, 2004, Paragraph No. 7 beginning on page 3; the First Final Office Action mailed February 14, 2005, Paragraph No. 9, beginning on page 4.

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with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵

Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁶ Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography *was* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁷ to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—has not changed the Examiner's reasonable conclusion that Applicant has decided not to be his own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See Note 3.

⁷ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was

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heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁸

Response to Arguments

18. Applicant’s arguments filed October 5, 2005 have been fully considered but they are not persuasive.

19. Applicant’s arguments with respect to the prior art have been considered but are not persuasive.

20. Regarding lexicography, Applicant argues on page 7 of his “Remarks” under the section titled “Comments on Response to Argument” that Applicant has provided a definition of server. In particular Applicant states argue “[t]he specification defines server at page 4, lines 21-23, as a position-measuring server that receives the three-dimensional position of the load 20, or the pallet via an Ethernet 70 network.” The Examiner respectfully disagrees.

21. First, a review of the original specification in which Applicant points to is in order. Page 4, approximately lines 19-23 expressly states:

Thus, the position of the load 20 is measured through the position of the pallet 21 on which the load 20 is mounted. The measured three-dimensional position of the

interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.”

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

load 20 or the pallet 21 is received by a radio relay 40, which is transmitted to a position-measuring server 50 via an Ethernet 70.

22. This cited passage is hardly a redefinition of the term “server.” If Applicant intended to redefine “server,” wouldn’t the specification state measured three-dimensional position of the load is simply transmitted ‘the server’ since “the position-measuring” would be encompassed by or within the redefined ‘server?’ Again to be especially clear, the Examiner has yet again reviewed the original specification. In light of this review and the prosecution history, the Examiner concludes that one can not objectively read the specification passage cited above and reasonably conclude that Applicant has unambiguously redefined the term “server” by clear and convincing evidence with the required clarity, deliberateness, and precision. For this reason, Applicant’s attempt at using lexicography for the term “server” is not persuasive. Applicant’s remaining statements in the “Comments on Response to Argument” have been considered and noted for the record.

Conclusion

23. References considered pertinent to Applicant’s disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

24. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100,

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1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. Applicant is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner.

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In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

27. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference, Production and Inventory Control Handbook, 3rd Ed. with James H. Greene as Editor-in-Chief ("Greene") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. First, the Examiner finds that Greene is an English language textbook that provides an introduction to the basics of production and inventory control. In other words, Greene covers production and inventory control in its broadest sense. The Examiner also finds that the reference is a introductory handbook which serves at least professionals, students, and persons designing control systems. The reference is cited in its entirety. In particular, Greene is about planning, controlling, and managing production and inventories through systems and an organization; and applying principles, methods, and models, based on facts, knowledge, forecasts, and predictions to accomplish goals and objectives. Finally, the Examiner finds that Greene includes discussions which are broad enough to include both large and small businesses; covers the process industries as well as the assembly and fabrication industries; covers businesses that produce to order as well as those that ship 'off the shelf;' and concerns itself with distribution inventories as well as

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manufactured inventory, from the simple manufacturing processes to the very complex. Because “[w]ell known text books in English are obvious research materials,” *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), because of the factual findings noted in this paragraph, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Greene is primarily directed towards those of low skill in this art. Because Greene is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Greene.

28. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 5) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁹ the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards

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allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 18, 2005

⁹ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.